



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

ml

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,746	09/18/2001	Robert Parisi	10251-049	9490
21890	7590	07/25/2007	EXAMINER	
PROSKAUER ROSE LLP			RINES, ROBERT D	
PATENT DEPARTMENT				
1585 BROADWAY			ART UNIT	
NEW YORK, NY 10036-8299			PAPER NUMBER	
			3626	
			MAIL DATE	
			DELIVERY MODE	
			07/25/2007	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/955,746	PARISI, ROBERT	
	Examiner	Art Unit	
	Robert D. Rines	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

[1] A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 May 2007 has been entered.

Notice to Applicant

[2] This communication is in response to the Request for Continued Examination (RCE) filed 2 May 2007. It is noted that this application benefits from Provisional Patent Application Serial No. 60/233,503 filed 19 September 2000. Claims 10-19 and 21-28 have been amended. Claims 10-28 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

[2] Claims 10-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Although Applicant remarks that support for the amendments filed 17 July 2006 and 2 May 2007 can be throughout the specification, and Applicant further submits that no new matter has been added hereby.

Examiner has further reviewed Applicant's Specification filed 18 September 2001 and submits that Applicant's newly added features including a computerized method that facilitates offering a customer insurance coverage, determining and issuing a quote, and upon customer accepting a quote providing an insurance policy as claimed in Applicant's newly added claims 10-20 are unsupported. Further, Examiner submits that Applicant's newly added claims 21-28, directed to a computerized system, method, and computer-readable media for mitigating internet-related risk by offering a customer user-selectable menus for selection of an insurance products

and subsequently quoting, issuing, and servicing a policy are similarly unsupported by Applicant's Specification filed 18 September 2001.

Specifically, the Specification filed 18 September 2001 is directed to a suite of different Internet-related coverages for persons who conduct business on the Internet as indicated in paragraphs [0001] and [0002] of the Specification. The Specification specifically discusses business risks associated with e-commerce and subsequently describes specific insurance policies that are intended to cover those risks. However, while the Specification indicates that the disclosed insurance policies provide protection for persons who conduct business on the internet, The Specification provides no enabling disclosure of the computerized method of presenting menus to a user to enable the selection of policy elements, calculating and presenting the user with a quote, and selling the insurance policy. In summary, Examiner's best understanding of the Specification filed 18 September is that it is directed specifically to the structural components and coverage options provided by an insurance policy.

Accordingly, claims 10-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[4] Claims 10-28 are rejected under 35 U.S.C. 102(e) as being anticipated by DiMattina (United States Patent #6,405,177).

Claims 1-9 have been cancelled.

As per (currently amended) claim 10, DiMattina discloses a computerized method for providing an insurance coverage to reduce potential liability associated with activities conducted on the internet, the method comprising: a. offering by an insurer to a customer a plurality of insurance coverages to cover a plurality of the customer's activities conducted on the internet (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54); b. in response to the customer selecting a set of insurance coverages from the plurality of insurance coverages, providing, by the insurer, a price quote for the set of insurance coverages (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54); and c. in response to the customer accepting the price quote, providing, by the insurer, insurance policy to the customer comprising the set of insurance coverages (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

As per (currently amended) claim 11, DiMattina discloses a computerized method wherein the plurality of insurance coverages comprises an insurance coverage for reducing a potential liability from at least one of the customer's advertising or marketing business conducted on the internet (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

As per (currently amended) claim 12, DiMattina discloses a computerized method wherein the insurance coverage includes a protection against liability arising from material published, transmitted, disseminated, distributed, serialized, created, originated, exhibited, displayed, or any combination thereof by the customer via the internet (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

As per (currently amended) claim 13, DiMattina discloses a computerized method wherein the insurance coverage includes protection for alleged wrongful acts committed by the customer, the alleged wrongful acts comprising libel, slander, product disparagement, trade libel, copyright infringement, title infringement, slogan infringement, trademark infringement, domain name infringement, trade name infringement, trade dress infringement, service name infringement, patent infringement, plagiarism, piracy, misappropriation of ideas under implied contract, or invasion, infringement, or interference with rights of privacy or publicity, or any combination thereof (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

As per (currently amended) claim 14, DiMattina discloses a computerized method wherein the plurality of insurance coverages comprises an insurance coverage to reduce a potential liability from at least one of errors by the customer in professional services rendered on the internet, omissions by the customer in professional services rendered on the internet, content of the customer's professional services rendered on the internet, or any combination thereof (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

As per (currently amended) claim 15, DiMattina discloses a computerized method wherein the plurality of insurance coverages comprises an insurance coverage to reduce a potential liability from allegations of tortious conduct committed by the customer in the rendering of professional services on the internet (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

As per (currently amended) claim 16, DiMattina discloses a computerized method wherein the plurality of insurance coverages comprises an insurance coverage to reduce a potential liability of the customer to a third party arising from a failure of the customer's network security that causes damage to the third party (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

Art Unit: 3626

As per (currently amended) claim 17, DiMattina discloses a computerized method wherein the plurality of insurance coverages comprises an insurance coverage to reduce a customer's potential liability from a network security failure of the customer's network caused by cyber-attack, wherein the customer's potential liability results from denial of services, loss of intangible assets, E-business interruption, cyber-extortion, computer attack rewards, crisis management, or any combination thereof (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

As per (currently amended) claim 18, DiMattina discloses a computerized method wherein any of the plurality of insurance coverages cover the customer's business conducted worldwide (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

As per (currently amended) claim 19, DiMattina discloses a computerized method wherein offering to a customer one or more insurance coverages comprises offering over the internet a price quote, by an insurer, for the plurality of insurance coverages over the internet (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

As per claim 20, DiMattina discloses a computerized method wherein the price quote is provided via a webpage (DiMattina; col. 4, lines 1-54).

Art Unit: 3626

As per claim 21, DiMattina discloses a computerized method for mitigating internet-related risk, the method comprising: a. offering to a customer via a user-selectable menu one or more insurance coverages for reducing liability associated with at least one of providing internet content, professional errors or omissions provided over the internet, third party network security, cyber extortion, loss of intangible property, business interruption, reward funds for reporting cyber criminals, funds for communications in times of crisis, or any combination thereof (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54); b. in response to the customer selecting a set of insurance coverages from the one or more insurance coverages, providing a price quote for the set of insurance coverages (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54); and c. in response to the customer accepting the price quote, providing an insurance policy to the customer comprising the set of insurance coverages (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

Art Unit: 3626

As per claim 22, DiMattina discloses a computerized method for reducing potential liability associated with conducting business on the internet, the method comprising: a. offering to a customer a user-selectable menu of insurance coverages (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54) comprising at least one of: i. a first insurance coverage for advertising or marketing business conducted on the internet; ii. a second insurance coverage for professional services rendered via the internet; iii. a third insurance coverage for protection against a third party liability for business conducted on the internet (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).; and b. in response to the customer selecting a set of insurance coverages from the user-selectable menu, providing an insurance policy comprising the set of insurance coverages (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

Art Unit: 3626

As per claim 23, DiMattina discloses a computerized method for mitigating risk associated with business conducted on the internet, the method comprising: a. offering via a user-selectable menu one or more insurance coverages for activities conducted on the internet (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54); b. in response to a user selecting a set of insurance coverages from the menu, performing a risk assessment based on the user's internet-related activities (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54); c. after the risk assessment is performed, offering a price quote to the user for the set of insurance coverages (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54); and d. in response to the user accepting the price quote, issuing an insurance policy including the set of insurance coverages (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

As per claim 24, DiMattina discloses a computerized method wherein the one or more insurance coverages comprises at least one of a first insurance coverage for advertising or marketing business conducted on the internet, a second insurance coverage for professional services rendered on the internet, a third insurance coverage for protection against a third party liability for business conducted on the internet, a fourth insurance coverage for network security when conducting business on the internet, or any combination thereof (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54)..

Art Unit: 3626

As per claim 25, DiMattina discloses a computer program tangibly embodied in a computer-readable medium containing instructions operable to cause data processing apparatus to: a. offer via a user-selectable menu one or more insurance coverages for activities conducted over the internet (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54); b. in response to a user selecting a set of insurance coverages from the menu, offer a price quote to the user for the set of insurance coverages (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54); and c. in response to the user accepting the price quote, issue an insurance policy including the set of insurance coverages (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

As per claim 26, DiMattina discloses a computer program tangibly embodied in a computer-readable medium wherein the one or more insurance coverages comprises at least one of a first insurance coverage for advertising or marketing business conducted on the internet, a second insurance coverage for professional services rendered via the internet, a third insurance coverage for protection against a third party liability for business conducted on the internet, a fourth insurance coverage for network security when conducting business on the internet, or any combination thereof (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54)..

Art Unit: 3626

As per claim 27, DiMattina discloses a system for storing digital data and retrieving digital data from a digital memory, the data stored in and retrieved from a computer-readable media, the data being associated with an insurance policy including one or more insurance coverages for reducing liability associated for activities conducted on the internet and stored in response to an insured party purchasing the insurance policy, wherein the digital data is retrieved from the digital memory in response to one of a retrieval request of a claim against the insurance policy (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54)..

As per claim 28, DiMattina discloses a system wherein the one or more insurance coverages comprises at least one of a first insurance coverage for advertising or marketing business conducted on the internet, a second insurance coverage for professional services rendered via the internet, a third insurance coverage for protection against a third party liability for business conducted on the internet, a fourth insurance coverage for network security when conducting business on the internet, or any combination thereof (DiMattina; Abstract and col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30, col. 3, lines 56-67, and col. 4, lines 1-54).

Regarding the remaining features of claims 10-28, as per the recitation of various risks and associated coverages to be offered, the Examiner respectfully submits that the differences between the applied prior art are only found in the nonfunctional data material (i.e., the type of data/coverage specified) and are not functionally involved in the steps recited. The steps of providing different coverages or coverage options would be performed the same regardless of the

Art Unit: 3626

data/types of coverage offered. The descriptive material does not alter the method steps or functionality of the method steps as currently claimed. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). For further guidance, note MPEP § 2106, common situations involving nonfunctional descriptive material are: “a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.”

Response to Remarks

Applicant's remarks filed 2 May 2007 have been fully considered but they are not persuasive. The remarks will be addressed below in the order in which they appear in the response filed 2 May 2007.

Applicant traverses rejection of claims 10-28 under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement.

Specifically, Applicant remarks:

"Applicant respectfully submits that one of skill in the computer programming and/or insurance arts would understand that the use of a computerized method and system (including computer

Art Unit: 3626

program) to provide such coverage or reduce such liabilities is inherent in Applicant's specification and is present throughout the application, even without explicit mention."

In response, Examiner has reviewed Applicant's specification (filed 18 September 2001) and maintains, as set forth in the previous Office Action, mailed 3 November 2006 and reiterated above, that the specification provides no mention of a computerized method including menu driven and component-based selection of insurance coverage or policy parameters.

Examiner submits that while one of ordinary skill in the insurance art would understand the various coverages and policies to which the Specification is directed, the provided disclosure would not enable one of ordinary skill in the computer programming art with sufficient background to construct the claimed computerized method, as per Applicant's amended claims as presented in the July 17 2006 amendment and further amended as per the 2 May 2007 amendment.

Applicant further remarks:

"Similarly, one of ordinary skill in the computer programming and/or insurance arts could, without undue experimentation, make or use a computerized method for mitigating internet-related risk and reducing a customer's potential liability for conducting business on the internet as recited by claims 21-24."

Art Unit: 3626

In response, Examiner respectfully submits that the issue at hand is not whether or not one "could make" a computerized method to provide the disclosed insurance policies but rather determining if sufficient support for the functional elements presented in the claims. Examiner respectfully reiterates that such support does not exist in the Specification filed 18 September 2001.

Applicant's remaining remarks are directed to claimed features that are unsupported by the Specification and are accordingly moot.

In conclusion, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 2 May 2007 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of DiMattina, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (mailed 3 November 2006), and incorporated herein.

Conclusion

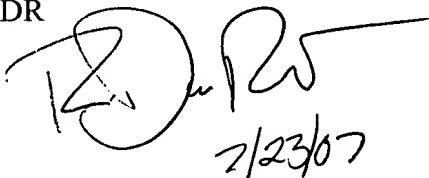
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D. Rines whose telephone number is 571-272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

Art Unit: 3626

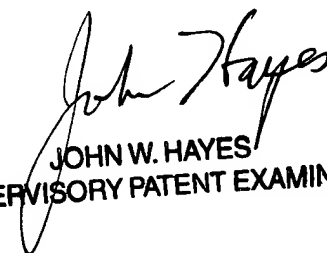
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RDR



2/23/07



JOHN W. HAYES
SUPERVISORY PATENT EXAMINER